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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/393,647	09/10/1999	HERBERT WOLTER	060953/0122	3048

7590 10/23/2003

FOLEY & LARDNER  
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WASHINGTON, DC 200078696

EXAMINER
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FORTUNA, ANA M

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/393,647	WOLTER ET AL.	
	Examiner	Art Unit	
	Ana M Fortuna	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-26 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8 (species II), 9, 10, 20, and 1(I, II, IV, V) is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1(III), 5-6, 11-13, 14-19 21(III-24, 25(III)-26 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is discussed on paper no. 19 (Office Action dated 3/23/03), and is maintained. Terms such as "optionally or if required", and redundant optional steps or composition render the claim confusing as when a predetermined composition is required or not.
2. Allowability of the elected species, as indicated in paragraphs 2-3 of paper No. 18, is also maintained.

### **Election of species**

The election of species as stated on Office Action signed on 12/12/2001, is maintained, and is made Final.

The election was made based on applicant's recognition that the prior art of record substantially teaches the invention of Formula IV (page 12, last paragraph, through page 12, first paragraph of "Remarks", filed on September 04 2001. The mentioned remarks, applicant distinguish his invention from the prior art stating "in the present invention additive must be present where they are required". The addition of additives in the claim (Claim 1) is however and option, and the additive must not be present in the claim as presented. Further applicant elects the invention of formula III, which is considered to have allowable subject matter as indicated in the previous action.

Applicant argues that search of the additional species can be made without serious burden, the M.P.E.P., section 803.02, states that in a Markush group including independent and distinct inventions, e.g. where the prior art anticipate the claim with respect to one of the members, but do not render the claim obvious over the other members, the Examiner may require a provisional election of a single specie, and with drawn the additional species. In the present invention, the species were originally considered to be equivalent, however, applicant's response clearly identify the species as distinct and further determined by the Examiner to be obvious over Scholze's references. Therefore, the election of Species is proper, at least two species have currently searched, with the later (specie of formula Iii) found to be allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

***Response to Arguments***

3. Applicant's arguments filed on 7/28/03 have been fully considered but they are not persuasive. Remarks regarding to election of species have been discussed above. The rejection of specie IV over Scholze's reference was not discussed in the prior Office action, since the invention of formula II was elected, however, it can be reinstated as pertaining to the claim directed to invention of formula IV, which is recognized by applicant's to be the same invention except that the addition of additives is not present in the composition of the prior art. However, the addition of additives is an option and therefore is not required in the present invention. The invention of species of formulas I, II, and V are withdrawn from consideration, which withdrawal is considered proper.

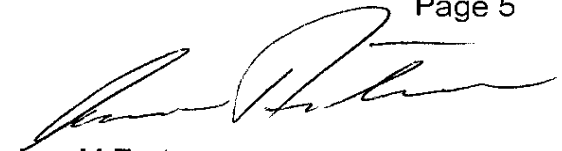
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana M Fortuna whose telephone number is (703) 308-3857. The examiner can normally be reached on 9:30-6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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A handwritten signature in black ink, appearing to read 'Ana M Fortuna', written in a cursive style.

Ana M Fortuna  
Primary Examiner  
Art Unit 1723

AMF